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09/606,426	06/28/2000	RICHARD HILICKI	HEH-2	6100

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**DEC 24 2002**

**GROUP 3700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**Paper No. 16**

Application Number: 09/606,426

Filing Date: June 28, 2000

Appellant(s): HILICKI ET AL.

Jeffrey D. Mullen

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 17, 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63 and 65-68 do stand and fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

Price, Karen and Miller, Ray, "The 50 United States", Tangerine Press, (1999), ISBN 0-439-20822-X

3,217,866

PHELPS

11-1965

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 8, 10-33, 35, 37, 40-58, 60, 61, 63 and 65-68 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 13.

**(11) Response to Argument**

Appellants' arguments filed on October 17, 2002 have been fully considered but they are not persuasive.

In regards to appellants' arguments that the prior art (ISBN) does not disclose placing the coin receivable apertures in the exterior of at least one of the covers and that the prior art "pertains more specifically to a way of storing coins in order to protect them, not actively displaying coins", the examiner submits that it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the apertures at any desirable location on the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. Furthermore, the prior art does not state that the coin book is used specifically as a "storage device". Since the coin book contains descriptive display material on the book as well as on the interior pages, one must conclude that this book's purpose is to display coins and a theme supporting the coins. By placing apertures and coins on the exterior of the cover, the cover's marketability is only further enhanced, as well as enticing for an observer to open the cover and review the material inside. Furthermore, operation of the device (display book) would not be modified, since shifting of the apertures and coins from the interior to the exterior only enhances the display, and the function of the book would be the same. The examiner also submits that appellants' statement that "applicant/appellants' coin display does not have to be opened in order to add, remove, or manipulate coins", leads one to conclude that appellants' invention is used more for storage purposes than for displaying.

In regards to appellants' argument that "the fact that the prior art could be modified would not have the modification obvious unless the prior art suggested the desirability of the modification", the examiner submits that the prior art does suggest desirability of the modification, since the display indicia on the front cover, the back cover, the spine cover and the interior pages entices a user to peruse through the display book. Any additional features only add to the display effect.

In conclusion the appellants' arguments that the location of the apertures and coins has a direct effect on functionality, the examiner submits that such modifications would produce no new or unexpected results in patentability.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Henderson  
Examiner



Will Fridie  
Primary Examiner



Andrea Wellington  
Supervisor, Art Unit 3722

December 20, 2002

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